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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,011	03/08/2007	Christ J. Pavlatos	26880-100961	1220
23644 7590 03/17/2010 BARNES & THORNBURG LLP P.O. BOX 2786 CHICAGO, IL 60690-2786				
EXAMINER PHONGSVIRAJATI, POONSIN				
ART UNIT 3686		PAPER NUMBER		
NOTIFICATION DATE 03/17/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent-ch@btlaw.com

Office Action Summary

Application No.

10/595,011

Applicant(s)

PAVLATOS ET AL.

Examiner

SIND PHONGSVIRAJATI

Art Unit

3686

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-13, 15, 18-20 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-13, 15, 18-20 and 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. In response to communication filed on 11/25/2009, claims 1, 9, 11-13, 15, 18-20, 22-28 are currently amended, claims 5, 10, 14, 16-17, 21, and 29-30 are canceled. Claims 1-4, 4-9, 11-13, 15, 18-20, 22-28 are now pending.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-4, 6-9 are rejected under 35 U.S.C. 101 because the claim language is directed towards non-statutory subject matter. As to claim 1, this claim recites a "web-based interface" for use in accessing a repository server.

In applying the broadest and most reasonable interpretation in light of the specification and the level of ordinary skill in the art, Examiner interprets these limitations to envelop software per se embodiments.

Claims 1-4, 6-9 are rejected under 35 U.S.C. 101 because data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In

contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

The Examiner acknowledges that claim 1 comprises using the web-based interface for accessing a repository server, however, according to Microsoft Computer Dictionary 5th Edition, a server can be defined as, "On the Internet or other network, a computer or program that responds to commands from a client". Since a server contains at least one non-statutory embodiment, claim 1 is directed towards non-statutory subject matter. Claims 2-4, 6-9 fail to cure the deficiencies of claim 1 and incorporate the same reasoning for rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 4-9, 11-13, 15, 18-20, 22-26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelson et al. (US 5,737,539) in view of Kozic (US 2003/0179287).

5. As to **Claims 1 and 6**, Edelson teaches of a web-based interface for use in accessing a repository server by a healthcare provider, the interface comprising: a

repository server including health-related information of a plurality of patients (Abstract, col. 8 lines 20-31); a web-based interface adapted to facilitate access to the health-related information on the repository server, wherein the web-based interface includes: at least one patient health record section adapted to display health-related information of a selected patient retrieved from the repository server (Abstract, Fig. 2, 3, col. 8 lines 20-31), and a banner section being operative to display information based on the content of the patient health record section, wherein the banner section includes a communications portal for hosting a communications session with a drug provider that is selected based on prescription information in the patient health record section (Fig. 3, col. 19 lines 36-60, col. 26 line 56 to col. 27 line 29). However, Edelson does not specifically disclose the communication session being an interactive communication portal session. Kozic does teach of an interactive video conferencing function for providing pharmaceutical services to remote sites (paragraphs 12-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to have an interactive communication session within the teachings of Edelson for the motivation for incorporating interactive computer-assisted decision making (Edelson, col. 50 lines 44-53).

6. As to **Claim 2**, Edelson teaches of the banner section further comprising a prescription ordering template related to prescription information in the patient health record section (col. 19 lines 26-35).

7. As to **Claim 3**, Edelson teaches of the interface of claim 1, the banner section further comprising a product ordering template related to information in the patient health record section (col. 19 lines 26-35).
8. As to **Claim 4**, Edelson teaches of the interface of claim 1, the banner section further comprising drug information related to the prescription information in the patient health record section (col. 19 line 28).
9. As to **Claim 7**, Edelson teaches of the interface of claim 1, the banner section further comprising a drug assistance request template, the drug assistance request template being automatically generated with a patient's health information based on the content of the patient health record section (Fig. 3, It is noted that the drug assistance request template reads on the Rx Options, Rx History, and Rx Info).
10. As to **Claim 8**, Edelson teaches of the banner section further comprising physician-customizable drug advertising (Fig. 14).
11. As to **Claim 9**, Edelson teaches of the interface of claim 1, the banner section further comprising an alert banner configured to display a commonly misdiagnosed illness responsive to one or more medical conditions in the patient health record section (col. 22 lines 44-54).
12. As to **Claims 11-13, 15, 18-19**, claims 11-13, 15, 18-19 substantially repeat similar limitations to claims 1-4, 6-9 as rejected above and are therefore rejected using the same rationale and reasoning.

13. As to **Claim 20**, Edelson teaches of a system of providing health services to a patient, the system comprising: a web-based patient health information system that displays patient information via a browser interface; a server with a database of health-related information, wherein the server is operable to communicate with the web-based patient health information system over a communication network; computer-executable instructions for performing steps comprising: retrieving at the .patient information system a health record of as elected patient (Abstract, col. 8 lines 20-31); displaying at least a portion of the health record on to the browser interface, the health record containing health record content (Fig. 2-3); comparing the content to the database of health-related information (col. 8 lines 20-31); retrieving information from the database of health-related information that is related to the content (col. 14 lines 19-24); and displaying the health-related information in a banner via the browser interface; selecting the banner to perform an action, wherein the action includes displaying a drug assistance application (Fig. 4-19, col. 33 lines 3-10); populating the drug assistance application automatically with the selected patient's health information (Fig. 4-19); connecting with a drug assistance program provider via the communication network (Fig. 4-19); sending the drug assistance application to the drug assistance pro_gram provider via the communication network (Fig. 4-19, col. 33 lines 3-10); a processor for executing the computer executable instructions; and a memory for storing at least the computer executable instructions (Abstract).

14. As to **Claim 22**, Edelson teaches of the system of claim 20, further comprising the action being displaying a prescription ordering template (col. 19 lines 26-35).

15. As to **Claim 23**, Edelson teaches of the system of claim 20, further comprising connecting to a drug provider over a communications network and electronically notifying the drug provider of a prescription (Fig. 3, col. 19 lines 36-60, col. 26 line 56 to col. 27 line 29).

16. As to **Claim 24**, Edelson teaches of the system of claim 23, further comprising the drug provider being a pharmacy (col. 25 lines 36-40).

17. As to **Claim 25**, Edelson does not specifically disclose the communication session being an interactive communication portal session. Kozic does teach of an interactive video conferencing function for providing pharmaceutical services to remote sites (paragraphs 12-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to have an interactive communication session within the teachings of Edelson for the motivation for incorporating interactive computer-assisted decision making (Edelson, col. 50 lines 44-53).

18. As to **Claim 26**, Edelson teaches of the system of claim 20, further comprising connecting to a database of illnesses and displaying an alert message in the banner in response to the content being related to a monitored illness (col. 22 lines 44-54).

19. As to **Claim 28**, Edelson teaches the alert banner further comprising information based on commonly misdiagnosed illnesses (col. 32 line 54 to col. 33 line 10).

20. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edelson et al. (US 5,737,539) in view of Kozic (US 2003/0179287) in further view of Applicant admitted prior art (AAPA).

21. As to **Claim 27**, the combination of Edelson and Kozic does not specifically disclose the database of illnesses being a database controlled by the Centers for Disease Control. However, it is well known in the art for the Centers for Disease Control to control a database of illnesses, for instance, the CDC may update a database for an upcoming pandemic, and official notice to that effect is hereby taken. Since Applicant did not adequately traverse Examiner's finding of official notice from the previous office action, the finding of official notice will be taken as Applicant admitted prior art (MPEP 2144.03). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the disclosure of Edelson and Kozic for the motivation for keeping an up-to-date database of illnesses.

Response to Arguments

22. Applicant's arguments with respect to claims 1-4, 4-9, 11-13, 15, 18-20, 22-28 have been considered but are moot in view of the new ground(s) of rejection.

23. Applicant also alleges:

If for some reason (not within contemplation at this time) another Official Action is required, it is respectfully requested that it be provided in non-final form since the subject matter relied on for patentability was previously examined in claim 5 (now cancelled and incorporated into amended claim 1). It is respectfully noted that any new or different rationale for the rejection of this subject matter would be considered a new ground of rejection, which would necessitate a non-final opportunity to respond. For example, it is urged that any of: (i) changing prior art relied on, (ii) changing from a 102-based to a 103-based rejection, or (iii) changing sections referred to in the prior art, or (iv) changing the rationale for the motivation for a modification/combination would necessitate a non-final opportunity to respond. See also MPEP § 706.07(a): "a second or subsequent action on the merits ... should not be made final if it includes a rejection ... of any claim amended to include limitation which should reasonably have been expected to be claimed."

Applicant is reminded that Applicant additionally amended the claims to include:

a web-based interface adapted to facilitate access to the health-related information on the repository server, wherein the web-based interface includes:

at least one patient health record section adapted to display health-related information of a selected patient retrieved from the repository server, and

A new ground of rejection is introduced based on Applicant's amendment not previously presented in the claim language.

Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SIND PHONGSVIRAJATI whose telephone number is (571) 270-5398. The examiner can normally be reached on Monday - Thursday 8:00am-5:00pm (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/S. P./
Examiner, Art Unit 3686

11 March 2010

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686